

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK A. SOMMERFELDT
and JAMES B. JORNLIN

Appeal No. 1997-3264
Application 08/501,769

ON BRIEF

Before KIMLIN, PAK and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-7. Claim 8, which is the only other claim remaining in the application, has been objected to as being dependent upon a rejected base claim, but the examiner states that this claim would be allowable if rewritten in independent form including all of the limitations of the base claim and any

intervening claims.

THE INVENTION

Appellants' claimed invention is directed toward a method for laminating a sheeted topfilm to a sheeted substrate while holding the topfilm in tension and maintaining registration between the topfilm and the substrate (specification, page 1, lines 7-10). Claim 1 is illustrative and reads as follows:

1. A method of laminating a sheeted topfilm to a sheeted substrate comprising the steps of:

a) registering the sheeted topfilm with the sheeted substrate;

b) removing the sheeted topfilm from the sheeted substrate, the sheeted topfilm being carried by a first platen;

c) activating a means for laminating the topfilm and the sheeted substrate to each other;

d) bringing a portion of the sheeted topfilm into contact with a portion of the sheeted substrate, the portions in contact defining a contact patch; and

e) moving the first platen relative to the sheeted substrate to advance the contact patch in a propagating direction across the sheeted substrate and laminate the topfilm to the sheeted substrate while simultaneously tensioning the sheeted topfilm in the propagating direction.

THE REFERENCES

Stebbins et al. (Stebbins) 2,084,625 Jun. 22,

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1937		
Bungay	2,624,389	Jan. 6,
1953		
Evans et al. (Evans)	3,146,485	Sep. 1,
1964		
Valimont et al. (Valimont)	4,367,107	Jan. 4,
1983		
Nomura (JP '217)	2-308217	Dec. 21,
1990		
(Japanese Kokai)		

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 102(b) as follows: claims 1-4 over Valimont, and claims 1 and 3 over Stebbins or Evans. The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-6 over Valimont in view of Bungay, and claims 1-4 and 7 over JP '217 in view of Valimont.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

Appellants' claim 1, which is the sole independent claim, requires laminating the sheeted topfilm to the sheeted substrate while simultaneously tensioning the sheeted topfilm

in the propagating direction. Appellants' only argument is that the applied references do not disclose or suggest this limitation (brief, pages 9-10).

Rejections under 35 U.S.C. § 102(b)

Rejection over Valimont

Valimont discloses "a method and apparatus for assembling sandwiches comprising a flexible sheet of interlayer material and a pair of bent glass sheets while the latter retain at least a portion of residual heat from their shaping" (col. 1, lines 9-12). The sandwich is formed by placing one side of the flexible interlayer on a lower glass sheet and then bringing the upper glass sheet into contact with the other side of the interlayer (col. 6, line 58 - col. 7, line 24). During this assembly the glass sheets are held by vacuum cups and the upper glass sheet retains its normal shape (col. 6, lines 36-39; col. 24, lines 67-68).

The examiner argues that the upper glass sheet, which the examiner considers to correspond to appellants' topfilm (answer, page 3), is simultaneously tensioned "to the extent that suspending portions of the sheeted topfilm cause tension

within the sheeted topfilms [sic, topfilm]" (answer, page 4).
The examiner points out that the claims do not require any particular amount of tensioning or require that the tensioning is applied in a controlled manner (answer, pages 7-8).

The examiner's position, as indicated by the arguments referred to above, is that some tensioning of Valimont's upper glass sheet is an inherent characteristic of the suspension of the upper glass sheet using vacuum cups.

When an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986).

The examiner has provided no basis in fact and/or technical reasoning in support of his inherency argument and,

therefore, has not carried the burden of establishing a *prima facie* case of anticipation over Valimont. Although, as pointed out by the examiner, appellants' claims do not require any particular amount of tensioning, the examiner has not provided any evidence or technical reasoning which shows that any tensioning at all necessarily would be produced by holding Valimont's upper glass sheet using vacuum cups.

Rejections over Stebbins or Evans

Stebbins discloses a method and apparatus for sealing overlapping portions of adjacent roofing sheets (page 1, right column, lines 13-16). A shoe-shaped heater is inserted between lapped portions of the sheets and is pushed along the seam to melt the bituminous coating on the underside of the upper sheet and top side of the lower sheet, and the pressure of the operator's feet as he walks along behind the device presses together the melted bituminous coatings on the sheets, thereby bonding the edges of the sheets (page 1, right column, lines 16-30; page 2, right column, lines 18-23 and 49-61).

Evans discloses an applicator for applying mastic under shingles (col. 1, lines 9-13). The applicator lifts the next

adjacent shingle while applying mastic under the preceding shingle (col. 1, lines 20-23; col. 2, lines 52-56).

The examiner argues that the Stebbins and Evans methods cause tension in the top films by suspending portions of them above the structure (answer, pages 4-5 and 8). The examiner, however, provides no basis in fact and/or technical reasoning in support of this argument. Such fact and/or technical reasoning would indicate why Stebbins' layer of softened or melted bituminous material necessarily is under tension, and why merely lifting the shingles in the Evans method places the shingles under tension. Moreover, appellants' claims require that the lamination takes place while the sheeted topfilm is tensioned, and the examiner has not explained why, even if a raised shingle is under tension, applying mastic below the raised shingle and then lowering the shingle onto the mastic meets the claim requirement of simultaneous lamination and tensioning.

We therefore find that the examiner has not established a *prima facie* case of anticipation over Stebbins or Evans.

Rejections under 35 U.S.C. § 103

Rejection over Valimont in view of Bungay

The examiner rejects claims 1-6 over Valimont in view of Bungay. The examiner's argument in support of this rejection, however, is directed only toward the limitation in dependent claim 5 regarding rotating a platen. The examiner does not explain why Bungay remedies the deficiency in Valimont discussed above regarding the tensioning limitation in appellants' sole independent claim. Consequently, the examiner has not established a *prima facie* case of obviousness over these references.

Rejection over JP '217 in view of Valimont

In the examiner's discussion of the rejection over JP '217 in view of Valimont, the examiner does not mention the tensioning requirement in appellants' independent claim or respond to appellants' argument (answer, page 10) that this tensioning feature is not disclosed or suggested in JP '217 and Valimont. The examiner, therefore, has not established a *prima facie* case of obviousness over these references.

DECISION

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The rejections under 35 U.S.C. § 102(b) of claims 1-4 over Valimont and claims 1 and 3 over Stebbins or Evans, and the rejections under 35 U.S.C. § 103 of claims 1-6 over Valimont in view of Bungay and claims 1-4 and 7 over JP '217 in view of Valimont, are reversed.

REVERSED

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EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
TERRY J. OWENS))
Administrative Patent Judge)	

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